

Application No.: 09/727,984
Preliminary Amendment dated: July 29, 2005
Reply to final Office Action of: March 23, 2005

REMARKS

By this preliminary amendment, Applicant has amended claims 1, 8, 13, 14 and 19. This preliminary amendment is submitted with a request for continued examination (RCE). In view of the amendments and remarks here, Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them.

Rejection Under 35 U.S.C. §103

The Examiner rejected claims 1-4, 6, 9, 10, 12-14, 16-19 and 21 as being unpatentable over Publication No. WO 98/12670 to Borza (hereinafter "Borza") in view of U.S. Patent No. 6,087,956 to Helferich (hereinafter "Helferich").

In particular, the Examiner asserted that the Borza reference taught all of the features of claims 1 and 13 except for the feature "*wherein said biometric data is operable to be removed from said portable computing device by a remote station on said computer network.*" This particular feature recited in claims 1 and 13 was asserted as being taught by Helferich.

In general, the Examiner relied on Helferich for teaching a paging transceiver that allows a user to erase information stored at the paging transceiver and corresponding information stored at a remote system. *See*, abstract of Helferich. Helferich describes this process in more detail at column. 14, lines 11-29, which states:

At step 131, the selected message to be erased is identified and the user is asked if the selected message in the paging transceiver is to be erased or if both copies of the message are to be erased. If the local message only is selected to be erased, the message identification information is kept and at step 133 the CPU 27 flags the message stored in memory 5 for erasure or overwriting. In other words, the message still exists but may be over-written by another message when memory space is required and, until then, may be retrieved from message memory 5. If at step 132 a decision was made to erase both copies of the message, then at step 134 the CPU 27 determines if a call is in progress. If yes, at step 135 the CI data is exchanged instructing system 30 to erase the message. At step 131, the system 30 transmits an acknowledgment that the message was erased, the CPU 27 flags the local message for

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erasure, the identifier is removed and both copies of the message and the identifiers are erased.

As is noted by this excerpt, Helferich defines a process wherein either the copy of the message is erased only locally, or the copy at the paging transceiver and the system 30 are both erased. In other words, Helferich only enables erasure of a remote copy upon erasure of all copies. This process is distinct from amended claims 1 and 13, which states that the *“biometric data is operable to be removed from said portable computing device on instruction by a remote station on said computer network, said remote station retaining a copy of said biometric data.”* In other words, a command to remove the biometric data at the portable device is made by a remote station without affecting the copy at the remote station. For at least this reason, Applicant submits that the rejection of claims 1 and 13 is traversed.

Moreover, Applicant submits that the combination of Borza and Helferich is not a proper combination. In justifying the combination of Borza and Helferich, the Examiner relied on the motivation of conserving memory space at the portable device. Applicant notes that removing installed biometric data from the portable device has nothing to do with conserving memory space. Rather, the purpose of removing installed biometric data is for security purposes in rendering the device inoperable until returned. *See*, page 14, lines 21-23 of Applicant’s specification.

Borza recognizes this purpose as well. At page 17, lines 11-17 of Borza, a mechanism is described for clearing data related to the biometric input from the buffer. This clearing of the buffer after a timeout period expires (*See*, FIG. 11 of Borza) increases security when the device is found or taken. In particular, the removal of the biometric input from the buffer would require a new entry of biometric data to be compared with the installed biometric data.

This security mechanism of Borza is quite distinct from Applicant’s solution. Whereas Borza focuses on removing input biometric data from the buffer, Applicant’s claimed invention removes the installed biometric data that is the basis for the biometric comparison. What is evident therefore is that Borza’s solution teaches away from Applicant’s claimed invention.

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The Examiner has not provided any evidence that would justify modifying the particular design of Borza's system. Indeed, Borza has taken specific design measures to solve a similar problem as the Applicant's invention, yet in a distinctly different way.

For at least this additional reason, Applicant submits that the rejection of claims 1 and 13 is traversed. Since claims 2-4, 6, 14, 16-19, and 21 are dependent from one of independent claims 1 and 13 and incorporate the features of one of those claims, the rejection of claims 2-4, 6, 14, 16-19, and 21 is traversed for at least those reasons noted above with respect to claims 1 and 13.

Applicant notes that claims 9, 10, and 12 were not validly rejected under the combination of Borza and Helferich. In particular, the Examiner has admitted that the features of independent claim 8, from which claims 9, 10, and 12 depend, is allegedly met only by the combination of Borza, Helferich, and U.S. Patent No. 5,712,912 to Tomko et al. (hereinafter "Tomko").

The Examiner rejected claim 5 as being unpatentable over Borza in view of Helferich and further in view of U.S. Patent No. 6,442,286 to Kramer (hereinafter "Kramer"). As claim 5 is dependent on claim 1 and incorporates the features of that claim, Applicant's traverse the rejection of claim 5 for at least those reasons noted above with respect to claim 1.

The Examiner rejected claim 8 as being unpatentable over Borza in view of Helferich and further in view of Tomko. Claim 8 recites similar features as claims 1 and 13. Accordingly, even assuming that Tomko teaches all that the Examiner alleges, the rejection of claim 8 is traversed for at least those reasons noted above with respect to claims 1 and 13.

Applicant notes that claim 11 was not validly rejected under the combination of Borza, Helferich and Kramer. In particular, the Examiner has admitted that the features of independent claim 8, from which claim 11 depends, is allegedly met only by the combination of Borza, Helferich, and U.S. Patent No. 5,712,912 to Tomko et al. (hereinafter "Tomko").

The Examiner rejected claims 20 and 22 as being unpatentable over Borza in view of Helferich and further in view of Kramer. As claims 20 and 22 are dependent on claim 13 and incorporates the features of that claim, Applicant's traverse the rejection of claims 20 and 22 for at least those reasons noted above with respect to claim 13.

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The Examiner rejected claim 15 as being unpatentable over Borza in view of Helferich and further in view of U.S. Patent No. 6,016,476 to Maes et al. As claim 15 is dependent on claim 13 and incorporates the features of that claim, Applicant's traverse the rejection of claim 15 for at least those reasons noted above with respect to claim 13.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might be useful for any reason.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

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By: / Reena Kuyper/
Reena Kuyper
Registration No. 33,830

9255 Sunset Blvd., Suite 810
Los Angeles, CA 90069
(310) 247-2860